

REMARKS/ARGUMENTS

In response to the Office Action mailed May 10, 2002, in connection with the captioned application, please consider the following remarks. Applicants are also submitting, concurrently herewith, a petition to extend the period of response three months from July 10, 2003 up to and including Friday, October 10, 2003.

Claims 4-6 and 38 are pending in the instant application. The following remarks are believed to be fully responsive to the Official Action.

**THE REJECTION UNDER 35 U.S.C. § 102
SHOULD BE WITHDRAWN**

Claims 4-6 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsuru, U.S. Patent No. 5,055,307 ("Tsuru"). In response, Applicants submit that each of the rejections should be withdrawn for the reasons stated below.

A finding of anticipation under 35 U.S.C. § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genetech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

As to Tsuru, Applicants respectfully submit that Tsuru is directed to delivery of drugs at the site of the embolus, and not the use of the embolytic particles containing a contrast agent for imaging purposes. There is no teaching or suggestion in Tsuru that the particles can be used for diagnostic imaging purposes or contain a diagnostic imaging agent as disclosed in the instant invention.

Furthermore, there is teaching or suggestion in Tsuru that there is "a non-radioactive diagnostically effective compound encapsulated in a non-polymeric particulate matrix selected from the group consisting of insoluble metal oxides, insoluble metal salts, inert metals, glass, ceramic particles and porous particles, or vesicles encapsulating a non-radioactive diagnostically effective compound, or a solution thereof, and wherein said composition further comprises an iodinated contrast agent, MR active agent, or ultrasound contrast agent imageable marker to identify the extent of embolization; and detecting the embolus location by a diagnostic imaging technique".

In view of the foregoing, claim 38 and the dependent claims are believed to be fully distinguished from Porter.

* Appl. No. 09/425,289
Amdt. Dated Oct. 10, 2003
Reply to Office action of Apr. 10, 2003-10-10

Thus, Applicants respectfully submit that each of the Examiner's rejections under 35 U.S.C. 102 has been overcome and/or obviated and respectfully request that the rejections be withdrawn.

Respectfully submitted,



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